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PATENT
Docket No. 54407US006IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Scott J. TUMAN et al.) Group Art Unit: 1762
Serial No.: 09/822,651) Examiner: Elena Tsoy
Confirmation No.: 9447)
Filed: 30 March 2001)
For: WEB HAVING DISCRETE STEM REGIONS

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REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Alexandria, VA 22313-1450

Sir:

This Reply Brief is presented in response to the Examiner's Answer dated December 29, 2004.

Claims 57 and 69

In reviewing the Examiner's Answer and the rejections currently pending after withdrawal of some of the rejections in response to Appellants' Brief, Appellants note that claim 57 (which depends from claim 56) does not stand rejected on any grounds. Furthermore, claim 69 depends directly from claim 57.

As a result, Appellants submit that claims 57 and 69 appear to be allowable.

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The remainder of Appellants' responses will be arranged by according to the grounds of rejection as addressed by the Examiner in the Examiner's Answer.

Claims 21-31, 33-35, 37, 39, 40, 42-48, 50-53, and 55 are patentable over Thomas (U.S. Patent No. 5,586,371) under 35 U.S.C. § 102(b).

Claims 21-31, 33-35, 37, 39, 40, 42-48, 50-53, and 55 stand rejected under 35 U.S.C. §102(b) over Thomas (U.S. Patent No. 5,586,371). Appellants respectfully disagree and request review and reversal of this rejection by the Board.

In the Examiner's Answer, continuing attempts are made to equate the loops of Thomas with stems as recited in the rejected claims in spite of the inconsistencies discussed in Appellants' Brief. As discussed at length in Appellants' Brief, loops are not stems, even under the broadest of reasonable interpretations. Even Thomas does not consider the loops disclosed therein to be stems, using the term stems in connection with only hooks, not loops.

The unreasonably broad definition relied on by the Examiner to support this rejection becomes even more apparent when reviewing the Examiner's comments with respect to claims 22, 45, and 48. Claims 22 and 45 each recite that "the web comprises loop structures adapted to lock with the plurality of stems." Similarly, claim 48 recites a web that comprises "loop structures" and a "plurality of stems ... adapted to lock with the loop structures of the web." In an effort to read the disclosure of Thomas on these claims, the Examiner asserts that "the web 24 comprises loop structures adapted to lock with the plurality of stems." *Examiner's Answer*, p. 4 (emphasis in original). In making this assertion, the Examiner is admitting that loops cannot be equated with stems, since both loops and stems (with decidedly different shapes) are required to function as a fastening apparatus. Taken as a whole, the conflicting assertions made in support of this rejection indicate that "loops" are "stems" unless hooks are needed, in which case "loops" are loops.

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Further evidence of the unreasonably broad nature of the Examiner's interpretation of the word "stem" is seen in connection with claim 39, where the Examiner asserts that Thomas teaches that "the plurality of stems comprises hook (*sic*) (See Fig. 2)." *Examiner's Answer*, p. 5. A review of Figure 2 of Thomas, however, shows hooks 44 on stems 46, but no loop shanks 28 that include hooks (because, in fact, the shanks 28 are part of loops that by definition cannot include hooks).

Clearly, the Examiner's interpretations of the teachings of Thomas made to support this rejection pass beyond the realm of a reasonable definition of the terms of the claims.

In addition, it is now asserted in the Examiner's Answer that the loops of Thomas have "distal ends 30". *Examiner's Answer*, p. 4. What is not presented is that the distal ends are attached to the base to form a loop. *See, e.g., Thomas*, Col. 5, lines 5-16.

It is also asserted in the Examiner's Answer that the "loops are *fused* to the substrate 24." *Examiner's Answer*, p. 3 (emphasis in original). As discussed in Appellants' Brief, Appellants disagree with the assertion that Thomas teaches polymeric regions that are "fused" to a substrate to a degree that supports an anticipation rejection. Thomas does not explicitly teach that the polymeric materials are "fused" to the substrate, but rather teaches only that the bases of the loops or hooks are "deposited" on the substrate. As such, the assertion that the bases of the hooks or loops of Thomas are fused to the substrate is based on inherency, i.e., that Thomas inherently teaches fused polymeric regions.

The standard for inherency with respect to anticipation, however, requires that the asserted result (i.e., fused polymeric regions) must necessarily result from the process disclosed in Thomas. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). *See also, In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) ("Inherency may not be established by

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probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.") Appellants respectfully submit that the burden of establishing anticipation through inherency has not been met in the present rejection.

For these reasons, along with those presented in Appellant's Brief, Appellants submit that claims 21-31, 33-35, 37, 39-40, 42-48, 50-53, and 55 are not anticipated by Thomas. Review and reversal of this rejection by the Board are, therefore, respectfully requested.

Claims 21-26, 28-31, 33, 39, 40, 42-48, 50-53, and 55 are patentable over Wessels et al. (U.S. Patent No. 5,669,120) under 35 U.S.C. § 102(b).

In the Appellants' Brief it was noted that claims 23, 42-48, 50-53 & 55, in one variation or another, recite an elastic web. Appellants noted that Wessels et al. does not teach the use of an elastic web and, thus, cannot anticipate these claims because Wessels does not teach each and every element of the rejected claims. *See, e.g., Shearing v. Iolab Corp.*, 975 F.2d 1541, 1544-1545, 24 USPQ2d 1133, 1136 (Fed. Cir. 1992); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), *cert. denied*, 493 US 853 (1989); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984), *cert. denied*, 469 US 857 (1984).

Appellants challenged the Examiner to identify where or how Wessels et al. taught the use of elastic webs to support the rejection of claims 23, 42-48, 50-53 & 55.

In response, it is asserted in the Examiner's Answer that in Wessels et al., "the web construction of a structure shown at Fig. 4A is elastic because a pile core sheet S is of a coarse woven or knit cloth with great flexibility (See column 6, lines 32-39)." *Examiner's Answer*, p. 6 (emphasis in original). Appellants respectfully disagree.

The assertion is, in essence, that "flexibility" is the same as "elastic" but no support is provided for equating the two different characteristics. Many articles can be flexible, but not

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elastic. For example, the steel belts in steel-belted radial automotive tires may be flexible, but they are not elastic. In the same way, many fabrics such as the woven or knitted fabrics disclosed by Wessels et al. may be flexible, but not elastic. Appellants submit that asserting that flexible substrates are elastic does not meet the standards required for an anticipation rejection.

Furthermore, although none of the claims subject to this rejection recite mushroom heads, Appellants want to address the assertion that "[t]he hook elements may be of hook- or mushroom-shape (*sic*) engaging element (See column 1, lines 19-20)." *Examiner's Answer*, p. 6 (emphasis in original). Review of Wessels et al. shows that the cited portion describes a piece of prior art (i.e., U.S. Patent No. 5,231,738), not the invention of Wessels et al. Furthermore, no discussion is provided as to how the processes described by Wessels et al. could be used to produce mushroom-shaped heads.

For these reasons, along with those presented in Appellant's Brief, Appellants submit that claims 21-26, 28-31, 33, 39, 40, 42-48, 50-53, and 55 are not anticipated by Wessels et al. Review and reversal of this rejection by the Board are, therefore, respectfully requested.

Claim 38 is patentable over Thomas (U.S. Patent No. 5,586,371) in view of Shephard et al. (U.S. Patent No. 6,205,623) under 35 U.S.C. § 103(a).

Claim 38 recites that "each stem of the plurality of stems comprises a mushroom head." In Appellants' Brief, it was submitted that claim 38 is not *prima facie* obvious over Thomas in view of Shephard et al. because the cited references do not teach or suggest all of the claim limitations.

In addition, Appellants noted that even if, for the sake of argument, a mushroom fastener is equivalent to a hook for fastening purposes, a *prima facie* case of obviousness would require some reasonable expectation of success for the asserted modification. The Examiner has asserted that the loops of Thomas are stems for the purposes of the present invention. A proper *prima*

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facie case of obviousness would require that the Examiner identify or discuss how or why one of ordinary skill in the art would modify the loops of Thomas to include mushroom heads as recited in claim 38. No such discussion has, however, been provided and, as a result, a *prima facie* case of obviousness has not been established.

Appellants note further that Shephard et al. does not teach or suggest the formation of a "mushroom head" on a loop. Such actions are limited to stems or hooks, not loops. Any assertion that Shephard et al. teaches or suggests the formation of a mushroom head on the loops of Thomas are, therefore, not supported by the cited references and cannot be relied upon as the basis for *prima facie* obviousness.

For these reasons, along with those presented in Appellant's Brief, Appellants submit that claim 38 is not *prima facie* obvious over Thomas in view of Shephard et al. Review and reversal of this rejection by the Board are, therefore, respectfully requested.

Claims 32, 41, and 54 are patentable under 35 U.S.C. §103(a) over Wessels et al. (U.S. Patent No. 5,669,120) in view of Murasaki (U.S. Patent No. 5,643,651)

In connection with this rejection, Appellants note that claims 41 & 54 stand rejected under 35 U.S.C. §103(a) over Wessels et al. in view of Murasaki. Claims 41 and 48, in one variation or another, recite an elastic web. In the response filed on April 23, 2004, Appellants noted that the cited references do not teach or suggest the use of an elastic web. In spite of Appellants' identification of the shortcomings of this rejection, the Examiner's Answer still does not identify why or how one of ordinary skill in the art would combine/modify Wessels et al. and Murasaki to reach the inventions recited in claims 41 and 48 (which recite an elastic web).

Because the Examiner has not identified why or how one of ordinary skill in the art would combine/modify the cited references to reach the inventions recited in claims 41 and 54, Appellants submit that a proper case of *prima facie* obviousness has not been established.

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For these reasons, along with those presented in Appellant's Brief, review and reversal of the rejection of claims 32, 41, and 54 as obvious over Wessels et al. in view of Murasaki are, therefore, respectfully requested.

Claims 40, 42-48, 50-53, 55, 56, and 58-70 are patentable under 35 U.S.C. §103(a) over Wessels et al. (U.S. Patent No. 5,669,120) in view of Allen et al. (U.S. Patent No. 5,547,531)

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. *See, e.g., In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

This rejection is based on the combination of Wessels et al. in view of Allen et al. in which the woven or knit web of Wessels et al. is replaced by the nonwoven fibrous web joined to an elastic backing as disclosed by Allen et al. In Appellants' Brief, we noted that the asserted combination does not possess a reasonable expectation of success as required for a proper *prima facie* case of obviousness because Wessels et al. describe in great detail the need for the polymeric material of the hooks to encapsulate the substrate. *See, e.g., Wessels et al.*, col. 3, line 1 to col. 4, line 67. In contrast, the elastomeric backings 34 of Allen et al. are generally described as films, with no specific need for openings that would allow encapsulation as discussed in connection with Wessels et al. As a result, the asserted modification of Wessels et al. using the substrates of Allen et al. would not reasonably be expected to form a successful product.

Furthermore, given the relative timing of the two patents, it seems clear that the inventors of Wessels et al. knew of the existence of nonwoven webs and dismissed their use in connection

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with their invention. In fact, Wessels et al. explicitly recite that woven or knitted webs are the only ones considered for use in connection with the process, stating that "since the pile core sheet is manufactured by weaving or knitting . . ." Wessels et al., col. 10, lines 54-56. It is clear that Wessels et al. did not contemplate that other substrates could be used in connection with their invention and the rejection based on Wessels et al. in view of Allen et al. provides no substantive reasoning as to why the proposed modifications would be attempted by one of ordinary skill in the art or successful if tried.

The Examiner's Answer has not addressed this basic deficiency in the asserted combination of Wessels et al. and Allen et al. as applied to claims 40, 42-48, 50-53, 55, 56, and 58-70.

Furthermore, with respect to independent claim 56 (and its dependent claims 58-70), Appellants note that independent claim 56 recites that the polymer of the at least one discrete polymeric region is entangled with a fibrous surface of the nonwoven web. The Examiner has not identified such a teaching in either Wessels et al. or Allen et al.

If it is the Examiner's intent to rely on inherency to supply the missing feature, the Examiner has not discussed how or why such a feature would inherently be found in either reference. The standard for inherency requires that the asserted result (i.e., entanglement) must necessarily result from the process disclosed in one of the references. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). *See also, In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) ("Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.") Appellants respectfully submit that the burden of establishing inherency has not been met in the present rejection.

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For these reasons as well as those presented in Appellants' Brief, we submit that claims 56 and 58-70 are not *prima facie* obvious over Wessels et al. in view of Allen et al. Review and reversal of this rejection are, therefore, respectfully requested.

Summary

For the foregoing reasons, Appellants respectfully request that the Board review and reverse the rejections of claims 21-48 and 50-70 as discussed herein and that notification of the allowance of these claims be issued.

Respectfully submitted,

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By

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Signature: Name: Rachel Gagliardi - Gabriela